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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/009,595      | 12/11/2001  | Makoto Tabata        | 482842000500        | 4248             |

25227 7590 02/26/2004  
MORRISON & FOERSTER LLP  
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EXAMINER

VERBITSKY, GAIL KAPLAN

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

2859

DATE MAILED: 02/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                        |                     |  |
|------------------------------|------------------------|---------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b> | <b>Applicant(s)</b> |  |
|                              | 10/009,595             | TABATA ET AL.       |  |
|                              | <b>Examiner</b>        | <b>Art Unit</b>     |  |
|                              | Gail Verbitsky         | 2859                |  |

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 01 November 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 4,8 and 23-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 4,8,23 and 25 is/are rejected.
- 7) ☒ Claim(s) 24 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Specification***

1. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification. The disclosure is objected to because of the following informalities: "to a back side of the person" and "a front side of a person", as stated in claim 8<sup>not</sup> are clearly<sup>^</sup> described in the specification. Appropriate correction is required.

### ***Claim Objections***

2. Claim 25 is objected to because of the following informalities: Perhaps "claim 22" in lines 1-2 should be replaced with —claim 23—since claim 22 has been cancelled. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 4, 8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In this case,

Claim 4: "used across a plurality of main-body-holding methods" in line 10 makes the claim language confusing because it is not clear what applicant means.

Claim 8: "to a back side of the person" and "a front side of a person" make the claim language confusing because it is not clear from the claims and specification what particular position/ location in the external canal of the person applicant means.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

6. Claims 23, 25 are rejected under 35 U.S.C. 102(a) as being anticipated by WO 99/04230 [hereinafter Konno].

Konno discloses in Figs. 2 and 7-9, 11 an ear thermometer comprising a main body configured to be held by an operator, a probe attached to the main body and protruding from it and configured to be inserted into an ear canal of a patient, a start measuring switch (indicator surface) 4 located on a substantially curved second side B opposite to a first side A. If to draw a plane C (reference plane) dividing the device into two symmetrical parts, the plane C will include a center axis D of the probe and also be a center of symmetry of the curved side wherein the curved surface of the curved side will be substantially constant along the length of the plane and perpendicular to the plane C. A center F of the curved surface is in the vicinity of a base G of the probe.

It is inherent, as understandable from the figures, that the operator can move his /her hand along the curved surface in order to chose (recognize) a comfortable position

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out of a plurality holding positions differing according to a direction in which the probe is being inserted (and the position of the patient, i.e., sitting, prone, supine, etc.). It is inherent that a switch serves as at least one indicator relative to which the operator can move the hand and to recognize (realize) where the hand is relative to the switch (indicator). The switch (indicator/ indicator surface) is arranged in a reference plane which contains the central axis of the probe. It is inherent that, serving as an indicator, the switch 4 will allow the operator to recognize the position of the main body relative to a reference (a finger placed onto the switch). It is also inherent that, dependent on the operator preference the reference can be an index finger of the operator. As shown in Figs. 9 and 11, the switch 4 constructed as a convex portion and arranged on each side relative to the reference plane.

Konno states (col. 13, lines 26-28), that the switch 4 can have any shape (or any number of switches), thus, in a broad sense, suggesting the particular shape for allowing the operator to recognize a holding method (to determine the position of the hand of the operator relative to the switch) by touching the switch 4, as shown in the attachment #2 to the Office action.

(Also see attachment #1 for the numerals A, B, C, D, F, G which have been added by the Examiner).

For claim 23: as shown in the attachment # 1, the indicator surface comprises first and second surfaces (two/ plurality) of surfaces arranged substantially symmetrically with respect to a reference plane C that contains a center axis of the probe.

7. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

***Allowable Subject Matter***

8. Claims 4, 8 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action.

9. Claim 24 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Response to Arguments***

10. Applicant's arguments with respect to claims 4, 8, 23-25 have been considered but are moot in view of the new ground(s) of rejection.

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***Conclusion***

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11. Any inquiry concerning this communication should be directed to the Examiner Verbitsky who can be reached at (703) 306-5473 Monday through Friday 7:30 to 4:00 ET.

Any inquiry concerning this communication should be directed to the group receptionist whose telephone number is 571/ 272-2253.

GKV

18 February 2004

Gail Verbitsky



Primary Patent Examiner, TC 2800

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